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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,149	11/22/2004	Herbert Muller-Hartmann	3029-101	5705
46/012 7590 08/05/2008 JOYCE VON NATZMER PIQUIGNOT + MYERS LLC 200 Madison Avenue Suite 1901 New York, NY 10016				
EXAMINER EDWARDS, LYDIA E				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/505,149

**Applicant(s)**

MULLER-HARTMANN ET AL.

**Examiner**

LYDIA EDWARDS

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 April 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.  
4a) Of the above claim(s) 21-25, 28-29 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-20, 26, 27 and 30-46 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

The examiner acknowledges the election of group I claims 1-20 and 26-27.

Applicant's arguments, see amendment, filed 4/30/2008, with respect to the rejection(s) of claim(s) 1-20 and 26-27 under 35 USC 103 (a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the receipt of the English translation of the foreign priority document.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 24 of copending Application No. 10/972294. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims recite an electrode (called formed body in claim 24, confirmation of this statement seen in claim 33 of copending Application No. 10/972,294). The electrode is made of a polymer, which is doped with a conductive substance. Claim 1 of the current application recites an overall concentration of dope in plastic material as 20-80%. Claim 24 of copending application 10/972294 does not recite a concentration of dope in the plastic.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to fabricate the plastic with dope concentration 20-80%, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 5 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 31 of copending Application No. 10/972,294. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims recite the same plastic materials (polycarbonate, polyetheretherketone, etc.).

Claim 6 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 32 of copending Application No. 10/972294. Although the conflicting claims are not identical, they are not patentably distinct from each other because each contain the same intrinsically conductive plastic material (polyaniline, polyacetylene, etc.).

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-11,19-20, 26, 31-34, 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Batliwalla et al. (US 4761541) in view of Baer (US 5128257) further in view of Modes et al. (US 4765874).

Regarding Claims 1, 3-4, 31-34, Batliwalla teaches a device with a resistive element composed of a first material (see claim 1 at column 24 line 44-46), which is a conductive polymer (see claim 4 at column 25 line 13-16) doped with conductive filler. The first material is bonded to a contact layer composed of a second material (see claim 1 at column 24 line 47-51), with a lower specific resistance at 23°C than the first material. Batliwalla teaches the device used in an electrode (see Abstract). Batliwalla teaches an electrode comprising every limitation of the instant claim, except using the electrode in a cuvette or at least one reaction chamber of a multiwell plate.

Baer teaches using an electrode in a cuvette (see Fig. 3; see also column 3 line 22-24). Baer teaches constructing an electroporation device comprised of two electrodes which are placed against the opposite walls of a flat-sided, open-topped cuvette (see column 5 line 64-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to construct a cuvette with the electrode taught by Batliwalla, in order to use the cuvette for electroporation.

Modes et al. teaches an electrode fabricated from an electroconductive plastic consisting of polymers and 5 to 80% of dope (graphite) by weight (see column 3 lines 8-10).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teaching of Batliwalla by fabricating an electrode from a plastic doped with a graphite content from 20 to 80% w/w as taught by Modes et al. because it makes a corrosion resistant electrode and provides the required electrical parameters of the electrode.

Furthermore, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious

design choice. *In re Leshin*, 125 USPQ 416. In addition it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ

Regarding Claims 2, Batliwalla teaches the first material composed of an organic polymer and particulate conductive filler (see claim 4 at column 25 line 13-16). The particulate conductive filler is a metal, graphite, or carbon black (see claim 5 at column 25 line 17-24).

Regarding claims 5 and 6, Batliwalla teaches the resistive element composed of a first material comprising a thermoplastic crystalline polymer such as an olefin polymer, including homopolymers, particularly polyethylene and the polyalkenamers obtained by polymerizing cycloolefins; copolymers of two or more olefins; and copolymers of one or more olefins, e.g. ethylene or propylene, with one or more olefinically unsaturated co-monomers, preferably polar co-monomers, e.g. vinyl acetate, acrylic acid methyl acrylate and ethyl acrylate (see column 7 line 26-36).

Regarding Claims 7 and 8, Batliwalla teaches the contact layer being composed of a conductive polymer (see claim 4 at column 25 line 13-16; see also column 16 line 14-15). In addition, Batliwalla teaches the contact layer may alternatively be made of a metallic member (see column 5 line 67-68).

Regarding claims 9-10, Baer teaches at least one electrode is integrated into the outer limit of a container and at least two electrodes being made of the same material (Figure 3).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Batliwalla by integrating an electrode into enclosure as taught by Baer because it simplifies the process of the cuvette fabrication.

Regarding Claim 11, Batliwalla does not explicitly state wherein at least two electrodes are made of different materials.

It would have been an obvious matter of design choice to use at least two electrodes of different materials, since applicant has not disclosed that using two electrodes of different materials solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with two electrodes composed of the same material.

Regarding claim 19, Batliwalla does not disclose a container wherein said outer limit comprises at least one opening for supplying said solution and at least one opening for draining off said solution.

Baer discloses a container wherein said outer limit comprises at least one opening for supplying said solution and at least one opening for draining off said solution (Figure 3). It would have been obvious to one of ordinary skill in the art to incorporate the electrode into the container of Baer to provide a device for electroporation.

Regarding claim 20, neither Batliwalla nor Baer explicitly state wherein a container arrangement comprises at least two containers being joined to build one.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to duplicate the single, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 26, Baer discloses a chamber for treating cells in a suspension, which inherently is aqueous (Col 3, lines 60-66).

Regarding claim 46, Baer discloses a container according to claim 1, wherein said at least one electrode has a surface that is plane-parallel to a surface of a second electrode (figure 3).

Claims 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Batliwalla et al. (US 4761541) in view of Baer (US 5128257) further in view of Modes et al. (US 4765874) as applied to claim 1 above, and further in view of Saito et al. (US 2002/0028368).

Regarding claim 14, Batliwalla does not disclose a container according to claim 1, wherein at least one electrode is made of polycarbonate doped with 15-40% w/w carbon fibers and 1-40% w/w graphite.

Saito et al. teaches electrically conductive resinous compositions superior in electrical conductivity, mechanical properties, chemical resistance and moldability, which include a thermoplastic resin ( see paragraph 0011 and 0025), an electrically conductive carbon powder and may be incorporated with optional additives such as fibrous base material (see paragraphs 0025 and 0046). This material is capable to be used as a material for the electrodes.

Saito et al. further teaches a resinous composition comprising a thermoplastic resin, which includes a polycarbonate resin (see paragraph 0026). The electrically conductive carbon powder is exemplified by flake graphite, massive graphite, artificial graphite, kish graphite and expansible graphite (see paragraph 0042). The carbon powder should be added in an amount of 100-10000 parts by mass for 100 parts by mass of the thermoplastic resin (see paragraph 0045) what is equal to 50-99% w/w of a total mass. The fibrous base material includes a carbon fiber, which should be used in an amount of 0-100 parts by mass for 100 parts by mass of thermoplastic resin (see paragraph 0047) what is equal to 0-50% w/w of a total mass.

Saito et al. does not teach that graphite is added at concentration 1-40% w/w. It would have been obvious to one having ordinary skill in the art at the time the invention was made to determine the optimal range of added graphite, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Also, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Batliwalla by fabricating the electrode from electrically conductive resinous composition comprising a polycarbonate resin doped with 0-50 % w/w of carbon fiber and graphite as taught by Saito et al. because it allows for the production of a material with the required electrical properties.



Regarding claim 15, Batliwalla does not disclose a container according to claim 1, wherein at least one electrode is made of polyetheretherketone doped with 30 - 50 % w/w carbon fibers.

Saito et al. teaches electrically conductive resinous compositions superior in electrical conductivity, mechanical properties, chemical resistance and moldability, which include a thermoplastic resin ( see paragraph 0011 and 0025). This conductive resinous compositions may be incorporated with optional additives such as fibrous base material (see paragraph 0046) and is capable to be used as a material for electrodes.

Saito et al. further teaches a resinous composition comprising a thermoplastic resin, which includes a poly-ether-ether-ketone resin (see paragraph 0026). Fibrous base material includes a carbon fiber, which should be used in an amount of 0-100 parts by mass for 100 parts my mass of thermoplastic resin (see paragraph 0047).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Batliwalla by fabricating the electrode from electrically conductive resinous composition comprising a poly-ether-ether-ketone resin doped with 0-100 % w/w of carbon fiber as taught by Saito et al. because it for the production of a material with required electrical properties.

Regarding claim 16, Batliwalla does not disclose a container according to claim 1, wherein at least one electrode is made of polyamide, preferably polyamide 66, doped with 20-40% w/w carbon fibers.

Saito et al. teaches electrically conductive resinous compositions superior in electrical conductivity, mechanical properties, chemical resistance and moldability, which include a thermoplastic resin ( see paragraph 0011 and 0025). This conductive resinous compositions may be incorporated with optional additives such as fibrous base material (see paragraph 0046) and is capable to be used as a material for electrodes.

Saito et al. further teaches a resinous composition comprising a thermoplastic resin, which includes a polyamide resin (see paragraph 0026). Examples of the polyamide resin include polyamide 66 (called nylon- 66) (see paragraph 0028). Fibrous base material includes carbon

fiber, which should be used in an amount of 0-100 parts by mass for 100 parts my mass of thermoplastic resin (see paragraph 0047).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Batliwalla by fabricating the electrode from electrically conductive resinous composition comprising a polyamide resin doped with 0-100 % w/w of carbon fiber as taught by Saito et al. because it allows to produce a material with required electrical properties.

Regarding claim 17, Batliwalla does not disclose a container according to claim 1, wherein at least one electrode is made of polypropylene doped with 20 % w/w carbon fibers.

Saito et al. teaches electrically conductive resinous compositions superior in electrical conductivity, mechanical properties, chemical resistance and moldability, which include a thermoplastic resin ( see paragraph 0011 and 0025). This conductive resinous compositions may be incorporated with optional additives such as fibrous base material (see paragraph 0046) and is capable to be used as a material for electrodes.

Saito et al. further teaches a resinous composition comprising a thermoplastic resin, which includes a polypropylene resin (see paragraph 0026). Fibrous base material includes carbon fiber, which should be used in an amount of 0-100 parts by mass for 100 parts my mass of thermoplastic resin (see paragraph 0047).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings Batliwalla by fabricating the electrode from electrically conductive resinous composition comprising a polypropylene resin doped with 0-100 % w/w of carbon fiber as taught by Saito et al. because it allows for the production of a material with the required electrical properties.

Regarding claim 18, Batliwalla does not disclose a container according to claim 1, wherein at least one electrode is made of polyphenylene sulfide doped with 30-50 % w/w carbon fibers.

Saito et al. teaches electrically conductive resinous compositions superior in electrical conductivity, mechanical properties, chemical resistance and moldability, which include a

thermoplastic resin ( see paragraph 0011 and 0025). This conductive resinous compositions may be incorporated with optional additives such as fibrous base material (see paragraph 0046) and is capable to be used as a material for electrodes.

Saito et al. further teaches a resinous composition comprising a thermoplastic resin, which includes a polyphenylene sulfide resin (see paragraph 0026). Fibrous base material includes carbon fiber, which should be used in an amount of 0-100 parts by mass for 100 parts by mass of thermoplastic resin (see paragraph 0047).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Batliwalla by fabricating the electrode from electrically conductive resinous composition comprising a polyphenylene sulfide resin doped with 0-100 % w/w of carbon fiber as taught by Saito et al. because it allows for the production of a material with the required electrical properties.

Regarding Claims 12, 13, 35-45, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select the preferred concentration of dope in said plastic material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Batliwalla et al. (US 4761541) in view of Baer (US 5128257) further in view of Modes et al. (US 4765874)), as applied to claim 1 in view of Hofmann et al. (US Patent 5676646).

Regarding claim 27, Batliwalla does not disclose a container according to claim 1, wherein said synthetic material is a transparent plastic.

Hofmann et al. teaches an electroporation container (90) (called cuvette chamber) wherein outer limit (92) (called enclosure) is fabricated from a clear plastic (see column 5 lines 46-48).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Beichmann et al. and Modes et al. by fabricating the enclosure from a clear plastic because it allows to conduct the optical analysis of the cells functions.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LYDIA EDWARDS whose telephone number is (571)270-3242. The examiner can normally be reached on Mon-Thur 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on 571.272.1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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